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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,986	03/24/2005	Robert Simm	3210	6382
<div>7590 Striker Striker &amp; Stenby 103 East Neck Road Huntington, NY 11743</div>				
			EXAMINER CADUGAN, ERICA E	
			ART UNIT 3722	PAPER NUMBER
			MAIL DATE 07/20/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/528,986

Applicant(s)

SIMM ET AL.

Examiner

Erica E. Cadugan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 6 and 8-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6 and 8-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Response to Amendment***

2. The amendment filed April 30, 2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the addition of an incorporation by reference statement to the foreign priority application DE 103 46 207.4.

Note that 37 CFR 1.57(a) does allow a priority/benefit claim to be considered an incorporation by reference of a prior-filed application, but only as to inadvertently omitted material. To now present a blanket incorporation by reference of the entire application, including potentially non-inadvertently omitted material, constitutes new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

#### ***Claim Objections***

3. Claim 16 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Note that claim 16 depends from claim 15, and thus includes all of the limitations from claim 15. Claim 15 sets forth that "the suction head has a suction part which forms with the dust

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container a one-piece unit”, and that claim 16 sets forth that “the suction part and the dust container are constructed in one piece”, which does not appear to further limit claim 15.

***Claim Rejections - 35 USC § 112***

4. Claim 21 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Re claim 21, it is noted that claim 21 sets forth that the air and removed material that are suctioned up through openings 30a, 30a-30c in the suction part 34a-34c are introduced perpendicularly to a working direction 24a “directly” into the dust container 12a-12c. However, it does not appear that the specification as originally filed supports that the introduction of the air and removed material “directly” (emphasis added) “via a duct section” (82a) into the dust container 12a-12c.

With respect to the first embodiment of Figures 1-6, note that the air and removed material suctioned up through openings 30a, 30a’, is introduced perpendicularly to the working direction 24a into the dust container 12a indirectly via duct section 82a.

With respect to the second embodiment of Figures 7-17, note that the dust and air suctioned up through the openings are introduced into the dust container indirectly via suction duct 60b (see Figure 13 and page 10, lines 1-3, for example).

With respect to the third embodiment of Figures 18-24, the specification as originally filed also does not specifically teach that the dust and air suctioned up through the openings are introduced into the dust container “directly”:

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In other words, claim 21 sets forth both that the air and removed material suctioned through openings in the suction part are introduced both “directly” into the dust container, and indirectly (“via a duct section”) into the dust container. Examiner suggests deleting the term “directly” in the penultimate line of claim 21 to overcome this issue.

5. Claims 6 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 6, “the unit” lacks sufficient antecedent basis in the claim (note that claim 4 sets forth both a “unit” and a “bearing unit” and thus it is unclear as claimed to which of these “the unit” in claim 6 refers -- note that reference characters in the claims are not given weight).

In claim 21, it is unclear, via the use of the indefinite article “a”, whether “a working direction” is intended to be the same “working direction” set forth in claim 1. If so, Examiner suggests changing “a working direction” in claim 21 to --the working direction-- or --said working direction--.

#### ***Claim Rejections - 35 USC § 102***

6. Claims 1-4, 6, 8-10, 12-23, any of which were rejected under 35 USC 112 above are as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Application Publication No. 2002/0141836 to Ege et al.

Ege et al. discloses a suction device for a power drilling tool 2 with at least one “dust container 20” and at least one “suction head” 1 to be placed on a work piece 8 (at portion 3 of the “suction head” 1), wherein the dust container 20 is “integrated in”, i.e., forms a part of or is incorporated in, the “suction head” 1 (see Fig. 1).

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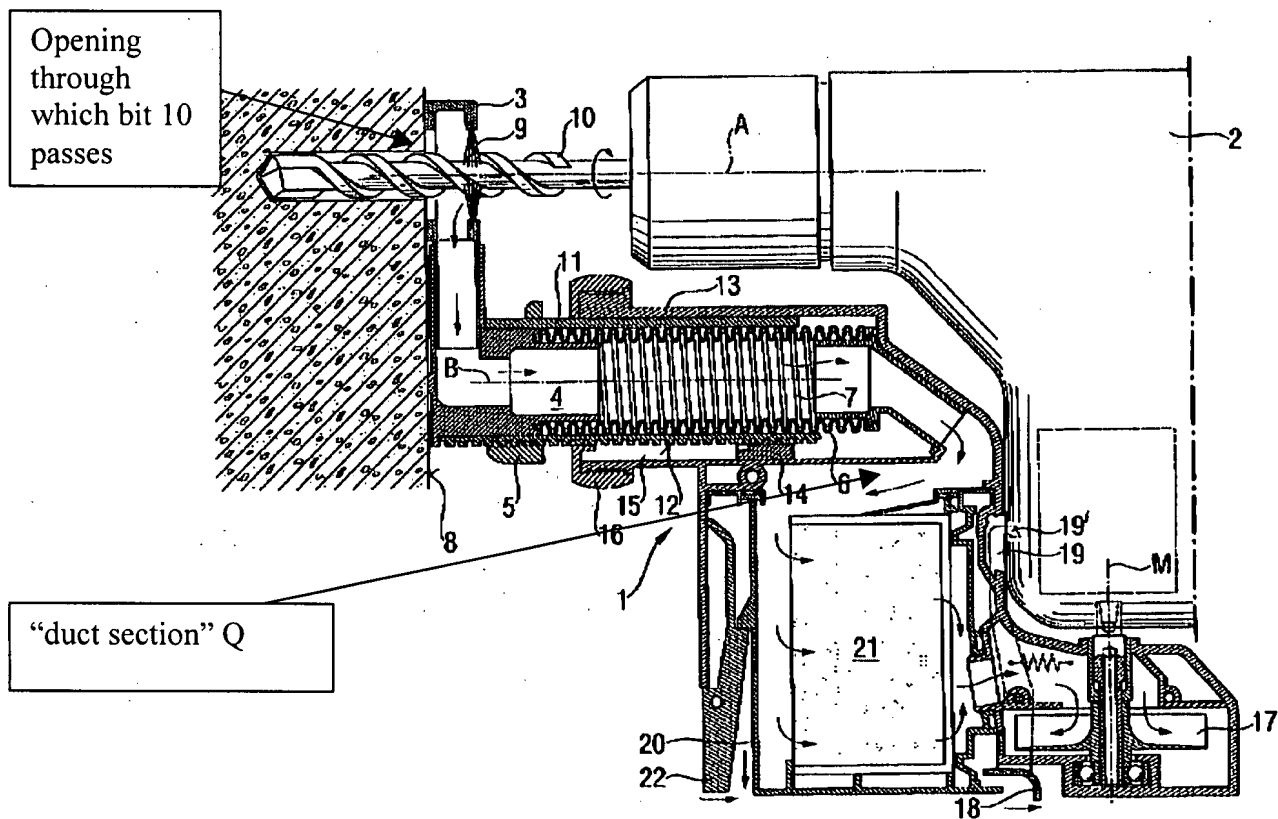
Re claims 2-3, a suction unit including the “cooling fan” 17 and the motor M is “integrated in” the power tool for producing a vacuum in the suction head (see Fig. 1).

Re the “bearing unit” of claim 1 and also re claim 6, note that the “suction head” 1 is supported on the housing of the power tool 2, and is detachably retained thereon via a snap-in connection 19, 19'. Re the claimed “unit” and “bearing unit” of claim 4, as broadly claimed, it is noted that a “unit” including a “bearing unit” including at least elements 13, 11, and 5 “support” the “suction head” 1 on the housing of the power tool 1 (insofar as the guide rods 46a and 48a forming the disclosed bearing unit of the present invention serve to support the suction head on the power tool housing).

Re claim 1, it is noted that the “suction head” 1 is supported on the housing of the power tool 2 by the “bearing unit” including at least elements 13, 11, and 5 as described previously. It is further noted that the suction head 1, including the integrated dust container 20, is indeed, as broadly claimed, “displaceable along a working direction” (such as the left right direction of the A axis of Figure 1) by, at the very least, moving the entire device (i.e., the power tool 2 in combination with the suction head 1) in the left-right direction as viewed in Figure 1, at the very least to move the device into a position adjacent the workpiece.

Re claim 8, note that the aforescribed “bearing unit” including at least elements 13, 11, and 5 includes the depth stop 5 (see Figure 1 and paragraph 0024).

Re claim 9, note that the suction head 1 includes an opening (labeled below in the reproduction of Figure 1) through which the tool bit 10 is guided during a drilling operation of the workpiece (workpiece is at the left side of the Figure and has a surface 8).



Re claim 10, it is noted that claim 10 broadly sets forth that "various dimensions can be selected for the opening". It is noted that it is considered inherent that, at the very least, during the design process of the suction head, the designer "can" (as broadly claimed) select any one of an infinite number of various dimensions for the opening size.

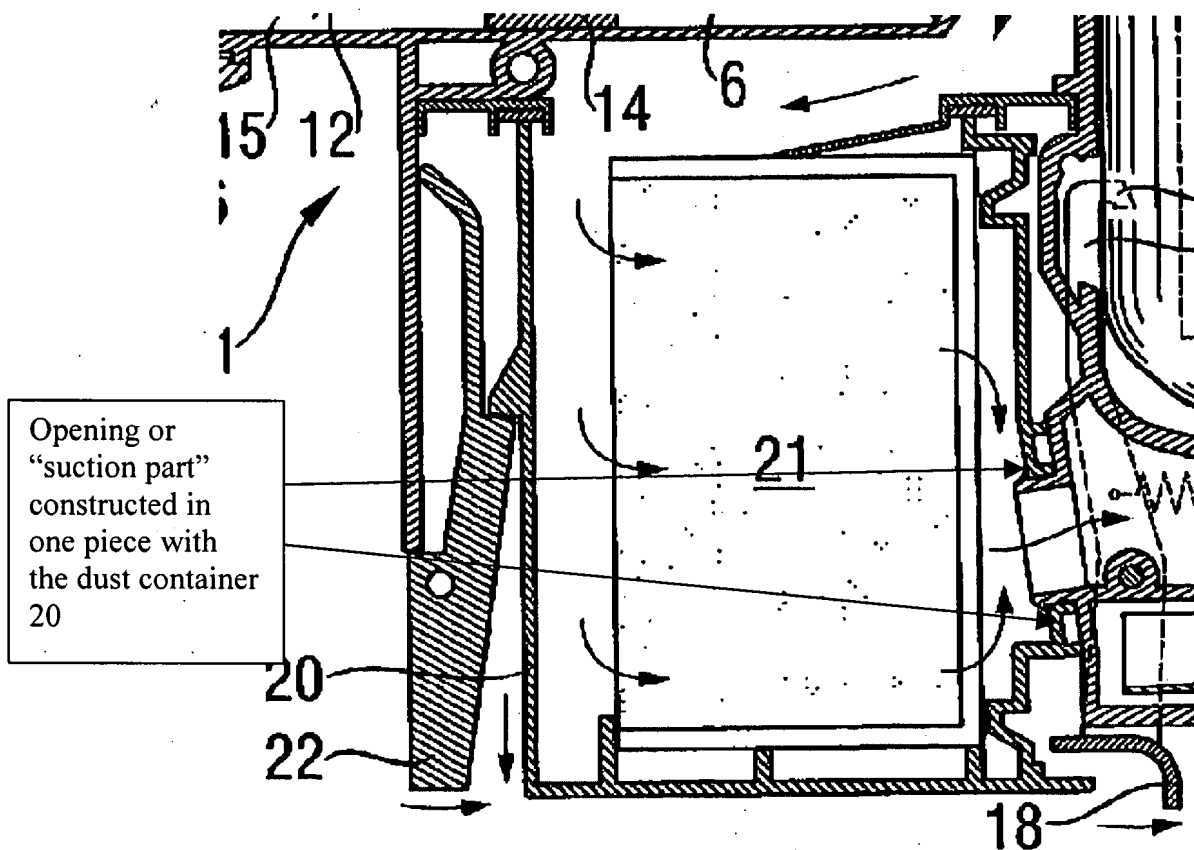
Re claim 12, an air stream (at least as defined by the arrows in Figure 1) is "capable" of being introduced into the dust container 20 through a "duct section" (including at least any one of the hollow portions 3 or the tube 4, or the above-labeled "duct section Q", for example) in a circumferential direction of the dust container (see Figure 1).

Re claims 14-15, it is noted that the "suction part" 34a-34c of the present invention is not any sort of vacuum, but is merely a part through which suction occurs. That being said, it is noted that the above-labeled "duct section Q" is a part through which suction occurs, and which

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is thus considered to be a "suction part", and which "forms a single unit" (claim 14) that "forms a one-piece unit" (see Figure 1 noting that at least the left side of the duct section Q is of the same piece as the container 20 (see Figure 1). [Alternately, note that the opening through which air passes as it leaves (on the right side) of the dust container is a part through which suction occurs, which could thus alternatively be considered the claimed "suction part", and which is a single unit that forms a "one-piece unit" with the "dust container" 20].

Re claim 16, considering the alternate interpretation of the "suction part" set forth in the immediately preceding sentence, see the enlarged and labeled portion of Figure 1 below.





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Re claim 17, note that as broadly claimed, at least any of the latch piece of the snap-in device 19, 19' of the power tool 2, or the housing of the power tool 2, or simply the power tool 2 itself, can be considered the claimed "second unit" noting that the aforescribed unit of the "suction part" and "dust container" is at least ultimately "detachably retained" on any of these items.

Re claim 18, it is noted that even considering the latch piece of the snap in device 19, 19' to be the claimed "second unit", the latches can be detached from the power tool by, at the very least, sawing or otherwise cutting them off, and are thus considered, as broadly claimed, to be "capable of being detachably retained on the power tool".

Regarding claim 19, note that filter 21 is ultimately supported "on" the "bearing unit" including at least elements 13, 11, and 5 (see Figure 1).

Regarding claim 20, it is noted that the housing of the power tool 2 can be considered the "second unit" as claimed as described previously, and thus, the single unit of the "suction part" and "dust container" is fixed by the snap-in connection 19, 19' at the side of the housing of the power tool 2 that faces the workpiece (having surface 8, see Figure 1).

Re claim 21, it is noted that air and removed material are suctioned up through left and right openings in element 3 (through which openings the tool bit 10 extends), and that such air and removed material are introduced "perpendicularly" to a working direction "A" of the tool bit "directly" (insofar as the present invention accomplishes such "directly") into the container 20, via the "duct section" labeled as Q above, for example, noting the direction of the flow arrows at the point just prior to entry into the container 20 is apparently perpendicular to the direction A. Alternatively, it is noted that the claim does not set forth specifics of the working direction, i.e.,

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working direction of what, and that the fan 17 rotates around a vertical axis, and that as the flow passes through duct section Q labeled above, it is perpendicular to the vertical “working direction” of the fan 17. Note also re this interpretation of the “working direction”, re claim 1, it is noted that the entire power tool is movable in a direction extending along the vertical working direction of the fan described previously, simply by the tool operator moving the tool in that direction prior to engaging it with a workpiece, for example.

Re claim 22, it is noted that the members 13 and 11 of the aforescribed “being unit” are considered to be “guide rods” as broadly claimed.

Re claim 23, note that Ege explicitly teaches that the power tool is a “drilling tool” or a “rotary hammer tool” (paragraph 0001).

7. Claims 1, 4, 8-11, 13-14, 17-18, 21, and 23, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 5,090,499 to Cuneo.

Cuneo teaches a suction device for a power drilling tool 38 (re claim 23) including a “suction head” 10 (including at least elements 26, 24, 12, 34, etc., see Figure 1) to be placed on a workpiece at the surface of the “suction head” 10 labeled in Figure 1 as 40. Dust container 34 is “integrated in”, i.e., forms a part of or is incorporated in, the “suction head” 10 (see Fig. 1).

Re claims 1 and 4, note that a “bearing unit” including at least collar element 16 serves to “support” the “suction head” 10 on the housing of the power tool 38 (see Figures 1, 2, and col. 2, lines 44-48). Also note that the bearing unit is “capable of being “detachably retained” on the power tool 38 by loosening and tightening the screw 17 so as to attach or detach the collar 16 from the tool 38 (see Figures 1-2 and col. 2, lines 44-48).

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Re claim 1 and the limitation regarding the suction head and integrated dust container being “displaceable” along a working direction, firstly, note that the “suction head” 10 is supported on the housing of the power tool 38 by the “bearing unit” including at least collar 16 as described previously. It is further noted that the suction head 10 is indeed, as broadly claimed, “displaceable along a working direction” (such as the left right direction of Figure 1) by, at the very least, moving the entire device (i.e., the power tool 2 in combination with the suction head 1) in the left-right direction as viewed in Figure 1, at the very least to move the device into a position adjacent the workpiece.

Re claim 8, it is noted that elements 24 and 31 can also be considered to be part of the “bearing unit” as broadly claimed, and that element 31 is a depth stop (see Figure 1 and col. 3, lines 11-13, for example).

Re claim 9, note that the “suction head” 10 includes an opening 44 on the left side of portion 26 and another opening on the right side of portion 26 through which the tool bit is guided during a drilling operation (see at least Figure 1).

Re claim 10, it is noted that “various dimensions” can be selected for the opening on the right side of portion 26 via the elastic membrane 43 (see Figures 1 and 6 and col. 2, line 64 through col. 3, line 2, for example).

Re claim 11, it is noted that the openings described previously of the portion 26 of the suction head 10 are shown in Figure 1 as forming ends of a funnel shaped receiving area that tapers in the horizontal working direction of the tool bit (see Figures 1 and 7 noting the tapered portions of the chamber 42).

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Re claim 14, it is noted that the “suction part” 34a-34c of the present invention is not any sort of vacuum, but is merely a part through which suction occurs. That being said, it is noted that duct 19 is a part through which suction occurs, and which is thus considered to be a “suction part”, and which “forms a single unit” (claim 14) with the dust container 34 by virtue of it (19) being threaded to the dust container 34. In other words, when the two are threaded together, they form a fastened “single unit”.

Re claim 17, it is noted that, as broadly claimed, the cylindrical part 39 of the drill 38 can be considered to be the claimed “second unit”, noting that the “single unit” including the duct 19 and dust container 34 are ultimately detachably retained on the “second unit” 39 via the screw 17/collar 16 arrangement described previously.

Re claim 18, it is noted that, as broadly claimed, the cylindrical “second” part 39 of the drill 38 is considered to be “capable of being detachably retained on the power tool” in that it is inherently able to be “detached” from the power tool by, at the very least, sawing or otherwise cutting it off.

Re claim 21, it is noted that air and removed material are suctioned up through left and right openings in element 26 (through which openings the tool bit extends), and that such air and removed material are introduced “perpendicularly” to a working direction of the screw 17 or a working rotation axis direction of the fan 13 “directly” (insofar as the present invention accomplishes such “directly”) via “duct sections” (see Figure 1) into the container 34 (see Figure 1, Figure 5).

***Response to Arguments***

8. Applicant's arguments filed April 30, 2007 have been fully considered but they are not persuasive.

Applicant's main argument appears to be that the structure of both the Ege (identified as a whole by element 1) and Cuneo (identified as a whole by element 10) references identified in the above rejections as a "suction head" cannot be considered to be a suction head because it is not located at an "outer end" of the "suction device".

However, Examiner notes that this appears to be an overly limiting definition of the term "head", and more particularly of the term "suction head".

Firstly, Applicant has provided the example of a "drill head" indicating that the drill head is located on an end of the system of the drilling tool. Examiner notes that this characterization does not appear to be accurate. For example, see U.S. Pat. App. Publication No. 2002/0122705 to Wehmeier, which teaches drill head 34 (see at least the abstract and Figure 1), and U.S. Pat. No. 5,915,894 to Okada et al., which teaches a "drill head" 14 (see Figure 1 and col. 4, line 8, for example). Note that the term "drill head" in these instances is used to describe the overall drilling unit, including the spindle, the spindle casing, the chuck, etc. By Applicant's interpretation of the term, it would appear that only the end of the structures 34 (for Wehmeier) and 14 (for Okada) at which the tool bit is actually located would be able to be considered a "drill head", which does not appear to be accurate.

Furthermore, it is noted that Merriam-Webster's Collegiate Dictionary, 10<sup>th</sup> ed. provides the relevant definition of a "head" as "the part of an apparatus that performs a particular function". Note that the structure indicated by the Examiner as a "suction head" in the Ege and

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Cuneo references performs the “particular” function of “suctioning”, and thus meets the definition.

Additionally, it is noted that Applicant has asserted that because Ege calls element 3 a “suction head” and that Cuneo calls element 26 a “suction head”, that the elements identified by the Examiner cannot be so considered. However, this is not persuasive, noting that, regardless of whether Ege and Cuneo call the structures 1 and 10, respectively, or 3 and 26 respectively, “suction heads”, or calls them “fish”, or “shovels”, or whatever they choose (noting that Applicant is permitted to be their own lexicographer), this doesn’t change the fact that the structures 1 and 10 identified by Examiner of the Ege and Cuneo references, respectively, can be considered to be “suction heads” based on the broadest reasonable interpretation of that term.

Also, Examiner notes that no claim language specifying that the suction head is at a “terminal end” or “outer end” (noting that no frame of reference for the term “outer” has been provided either) of any particular structure has been provided. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Finally, it is noted that the structure identified by Examiner as a “suction head” in the Ege and Cuneo references is located at an “end” of the tool as a whole.

It is again (as it was in the office action mailed in January 2007) also further noted that Applicant may wish to additionally take at least BE 1009324 (already of record) into careful consideration when crafting any future amendments to the claims, noting that as shown in Figure 1 and described in the English abstract thereof, “suction head” 1 (having hole 23 through which drill bit 20 is guided in operation) having surface 3 to be placed against a workpiece (see Figures

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2-3) has a dust container 7 incorporated therein, and wherein turbine wheel 5 is used to draw air (through filter 6) and debris perpendicularly to the working axis of the tool "directly" into the dust container 7. Furthermore, BE 1009324 teaches the use of guide rods 21, 22, and it is noted that the suction device is detachably connected (via collar 12 and wing nut 14) to the drill (see Figure 1), for example.

### *Conclusion*

9. Applicant's amendment necessitated any new ground(s) of rejection (such as any new issue with respect to 35 USC 112) presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erica E. Cadugan whose telephone number is (571) 272-4474. The examiner can normally be reached on M-F, 6:30 a.m. to 4:00 p.m., alternate Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica S. Carter can be reached on (571) 272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Erica E Cadogan  
Primary Examiner  
Art Unit 3722

eec  
July 18, 2007